

Remarks

Applicant has carefully reviewed the Office Action of April 14, 2006 in which claims 1-41 are pending and have been rejected. Claims 1 and 28 have been amended.

Claim Rejections 35 U.S.C. § 102

Claims 1-4, 6, 8, 15-18, 21 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fogelberg (U.S. Patent No. 5,186,329). Applicant respectfully traverses the rejection.

Fogelberg is directed towards a tool holder adapted to be received within a standard five-gallon dry wall pail or like container. The tool holder is subdivided into a number of compartments by a number of vertical walls with the highest and deepest compartments located near the periphery and the lowest and shallowest compartments located near the center. See abstract. At least the outer wall of the tool holder is composed of a relatively rigid material, which allows the invention to be used without the support of a bucket. Col 2, ll. 54-56, 65-69.

However, Fogelberg does not disclose a “tool insert including a holster substantially spanning the opening” as claimed in claim 1. For at least this reason, applicants submit that claim 1 is allowable over Fogelberg as well as claims 2-4, 6, 8, and 15, which depend from claim 1 and contain additional elements.

Claim 16 recites “fastening means for releasably securing the tool insert to the upper end of the container.” The examiner cites upper margin 26 as fastening means and calls attention to lines 1-3 of column 2: “The invention comprises a portable tool container adapted to fit within a standard five gallon bucket.” However, upper margin 26 merely appears to be the upper lip of the tool container and Fogelberg does not disclose

fastening the tool container to the bucket. In contrast, the tool container of Fogelberg merely sits within the bucket much like one stackable cup may sit within another. For at least this reason, applicants submit that claim 16 is in condition for allowance over Fogelberg as well as claims 17-18, 21 and 27 which depend therefrom and contain additional elements.

Claim Rejections—35 U.S.C. § 103

Claims 5 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fogelberg as applied to claims 1 and 16 and further in view of McAfee (U.S. Patent No. 5,271,520). Applicant respectfully traverses the rejection.

As discussed above, Fogelberg does not disclose each and every claim element of claims 1 or 16, from which claims 5 and 19 respectively depend. McAfee, which pertains to a fishing apparatus, does not remedy this deficiency. For at least this reason, applicant submits that these claims are in condition for allowance.

Claims 7, 10-14, 20, 23-26, 28-30, 32-35 and 37-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fogelberg as applied to claims 1 and 16 and further in view of Lindsay et al. (U.S. Patent No. 4,993,551). Applicant respectfully traverses this rejection.

As discussed above, Fogelberg does not disclose each and every claim element of claims 1 or 16, from which claims 7, 10-14 and 20 and 23-26 respectively depend. Lindsay, which pertains to a tool holder and storage device to interfit over the upper rim of a five gallon bucket, does not remedy this deficiency. For at least this reason, applicant submits that these claims are in condition for allowance.

With regard to claim 28, applicant respectfully submit that no prima facie case of obviousness has been established. To establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the references or to combine the reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Claim 28 recites both “a bucket mounted tool carrier” and “a tool insert.” In this case, if one were to first insert the tool holder of Fogelberg into a bucket and then drape the tool holder of Lindsay over it, the interior panel of Lindsay would cover most of the openings of Fogelberg. If tools were put into the pockets of Lindsay as shown in Fig. 1, there would be no practical way of lifting the interior panel of Lindsay to gain access to Fogelberg. This would frustrate one of the principal objects of Lindsay, which is “maintaining ease of access to the tools carried within the bucket.” Col. 1, ll. 62-64. One could also put the tool holder of Lindsay on the bucket first and then insert the tool holder of Fogelberg. However in this case, the pockets on the interior panel of Lindsay would be completely inaccessible. Two of the objects of Fogelberg are “to provide a tool holding device that holds tools not only on the inside surface of the bucket, but also holds tools on the outside surface of the bucket” and “to provide a tool holder and storage device which can utilize a bucket to support the tool holding device as well as utilizing

the bottom of the bucket to provide an additional open storage area and carrying area for small parts, fastening devices and other materials.” Col. 1, ll. 54-57 and 37-42. It is evident that the tool holders of Fogelberg and Lindsay are fundamentally incompatible with each other; no one of skill in the art would try to combine the two. It is consequently not at all obvious for one of ordinary skill in the art to modify the container of Fogelberg to include the bucket mounted tool carrier of Lindsay. Further, applicant cannot conceive of any user regarding a combination of Fogelberg and Lindsay as superior to either one used alone. For at least this reason, applicant submits that claim 28 is in condition for allowance. As claims 29-30, 32-35 and 37-49 depend from claim 28 and contain additional elements, applicant submits that these claims are in condition for allowance as well.

Claims 40 and 41 also recite both “a bucket mounted tool carrier” and “a tool insert” and so for the reasons discussed above with respect to claim 28, applicant submits that these claims are also in condition for allowance.

Claims 9 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fogelberg as applied to claims 1 and 16 above and further in view of Dillon (U.S. Patent No. 5,678,509). Applicant respectfully traverses the rejection. As discussed above, Fogelberg does not disclose all the elements of claims 1 or 16, from which claims 9 and 22 respectively depend. Dillon, which pertains to an all in one litter box, sleeping area, food and water system and pet carrier, does not remedy this deficiency. For at least this reason, applicant submits that these claims are in condition for allowance.

Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fogelberg and Lindsay as applied to claim 28 above and further in view of McAfee. As

discussed above, no prima facie case of obviousness has been made with respect to claim 28, from which claim 31 depends. McAfee does not remedy this deficiency. For at least this reason, applicant submits that claim 31 is in condition for allowance.

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fogelberg and Lindsay as applied to claim 28 and further in view of Dillon. As discussed above, no prima facie case of obviousness has been made with respect to claim 28, from which claim 36 depends. Dillon does not remedy this deficiency. For at least this reason, applicant submits that claim 36 is in condition for allowance.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance, issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

DAVID P. FIEREK

By  his Attorney.

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Glenn M. Seager, Reg. No. 36,926
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Tel: (612) 677-9050